

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE HONORABLE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of

Zhibi Wang

Application No.: 10/692,207

Examiner: J. H. Park

Filed: October 23, 2003

Docket No.: LUTZ 2 00243

Case Name/No. Wang 5-2

Title: METHOD FOR CLIENT-BASED MULTICAST MESSAGE TRANSMISSION

BRIEF ON APPEAL

Appeal from Group 2619

John S. Zanghi, Esq., Reg. No. 48,843  
FAY SHARPE LLP  
The Halle Building – Fifth Floor  
1228 Euclid Avenue  
Cleveland, OH 44115  
216-363-9000  
Attorneys for Appellants

**CERTIFICATE OF TRANSMISSION**

I hereby certify that this correspondence (and any item referred to herein as being attached or enclosed) is (are) being transmitted to the USPTO by electronic transmission via the EFS Web on the date indicated below.

March 5, 2009  
Date

Roseanne Giuliani  
Name:

TABLE OF CONTENTS

	<u>Page</u>
I. REAL PARTY IN INTEREST .....	1
II. RELATED APPEALS AND INTERFERENCES .....	2
III. STATUS OF CLAIMS .....	3
IV. STATUS OF AMENDMENTS .....	4
V. SUMMARY OF CLAIMED SUBJECT MATTER.....	5
VI. ARGUMENT .....	8
A. Claims 2-9 would not have been obvious over Kall in view of Jiang and further in view of Tesink .....	8
B. Claims 10-16 would not have been obvious over Kall in view of Jiang and further in view of Tesink.....	12
VII. CLAIMS APPENDIX: .....	17
VIII. EVIDENCE APPENDIX .....	21
IX. RELATED PROCEEDINGS APPENDIX.....	22

I. REAL PARTY IN INTEREST

The real party in interest for this appeal and the present application is Lucent Technologies, Inc., by way of an Assignment recorded in the U.S. Patent and Trademark Office at Reel 014637, Frame 0801.

## II. RELATED APPEALS AND INTERFERENCES

There are no prior or pending appeals, interferences or judicial proceedings, known to Appellants, Appellants' representative, or the Assignee, that may be related to, or which will directly affect or be directly affected by or have a bearing upon the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 2-16 are on appeal.

Claims 2-16 are pending.

Claims 2-16 are rejected.

Claims 1 and 17-20 are cancelled.

IV. STATUS OF AMENDMENTS

No Amendment After Final Rejection has been filed.

## V. SUMMARY OF CLAIMED SUBJECT MATTER

The invention of claim 9 is directed to a method for client-based multicast message transmission (see FIG. 4). The method includes receiving, from a messaging client, a message content to be transmitted in a message (paragraph [0033]), receiving delivery information for first and second recipients to whom the message is to be transmitted (paragraph [0034]), receiving an instruction to begin the message transmission (paragraph [0035]), transmitting the message from the client to the first recipient (paragraph [0036]), and transmitting the message from the client to the second recipient (paragraph [0037]). The method also includes receiving a report indicating an outcome for the message transmission to the first recipient (paragraph [0037]) and receiving a report indicating an outcome for the message transmission to the second recipient (paragraph [0037]).

The invention of claim 10 is directed to a method for client-based multicast message transmission (see FIG. 4). This method includes receiving, from a messaging client, a message content to be transmitted in a message (paragraph [0033]), receiving delivery information for first and second recipients to whom the message is to be transmitted (paragraph [0034]), receiving an instruction to begin the message transmission (paragraph [0035]), transmitting the message to the first recipient and a request for a response indicating an outcome for the message transmission (paragraph [0036]), and transmitting the message to the second recipient and a request for a response indicating an outcome for the message transmission (paragraph [0037]). The method also includes receiving a report indicating an outcome for the message

transmission to the first recipient (paragraph [0037]) and receiving a report indicating an outcome for the message transmission to the second recipient (paragraph [0037]).



GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The following grounds of rejection are presented for review:

1) Claims 9, 4-8, 10, and 13-16 are rejected as having been obvious under 35 U.S.C. §103(a) over Kall (US 7,149,195) in view of Jiang (US 2002/0057678) and further in view of Tesink (US 2004/0225733).

2) Claims 2, 3, 11 and 12 are rejected as having been obvious under 35 U.S.C. §103(a) over Kall (US 7,149,195) in view of Jiang (US 2002/0057678) and Tesink (US 2004/0225733) and further in view of Paila (US 2003/0227916).

## VI. ARGUMENT

- A. Claims 2-9 would not have been obvious over Kall in view of Jiang and further in view of Tesink

Claim 9 recites the steps of (a) receiving from a messaging client message content to be transmitted in a message and (b) receiving delivery information for first and second recipients to whom the message is to be transmitted. These steps are described, for example, in FIG. 4 and in paragraphs [0033-0037] of the specification.

Appellants submit that none of the cited references discloses at least the aforementioned features of independent claim 9. In particular, it is submitted that the additional citation to Tesink does not remedy the conceded deficiencies in the primary citation to Kall and in the secondary citation to Jiang. Accordingly, without conceding the propriety of the asserted combination, the asserted combination of Kall with Jiang and Tesink is likewise deficient, even in view of the knowledge of one of ordinary skill in the art.

The Final Office Action concedes that the primary citation to Kall does not disclose receiving from a messaging client message content to be transmitted in a message and receiving delivery information for first and second recipients to whom the message is to be transmitted. (Final Office Action, page 3). Nonetheless, the Final Office Action rejects independent claim 9, contending that the additional citation to Tesink provides this necessary disclosure. (Final Office Action, page 3). This contention is respectfully traversed.

Reference is made to FIG. 1 of Kall. As detailed in the corresponding columns 5 and 6 of Kall, the apparatus 46 includes an identifier 48 and a RANcast implementer 52. The identifier 48 identifies the number of mobile user endpoints that request, or shall

likely request, download of multicast data from the multicast source to the respective endpoints. For each cell defined by each base station of a particular RAN, the identifier 48 identifies how many mobile user endpoints request, or are likely to request, download of the multicast data. The implementer 52 defines a common channel and effectuates downloading of the multicast data to each of the mobile user endpoints that are to receive such data. Thus, the data is not obtained from the client, but rather, is delivered to the client.

This is quite different from the claimed invention. As presented in claim 9, the message is provided by a messaging client, whereby the message is delivered to multiple recipients. Thus, information flows from the creator of a message to multiple recipients via the exemplary messaging system.

The secondary citation to Jiang relates to a system and method for integrating wireless data and voice calls and is cited for its alleged disclosure of receiving a report indicating an outcome for the message transmission to the first recipient and receiving a report indicating an outcome for the message transmission to the second recipient. (Jiang, FIG. 1). Appellants submit that Jiang does not add anything that would remedy the aforementioned deficiencies of Kall.

The additional citation to Tesink relates to a multicasting notification system. (Tesink, FIG. 1.) Tesink discusses the concept of SMS based agents 604 for multicasting the message to SMS-based subscribers 618. But Tesink does not teach or suggest the concepts of receiving from a messaging client message content to be transmitted in a message and delivery information for first and second recipients to whom the message is to be transmitted. As such, Tesink does not add anything that would remedy the aforementioned deficiencies of Kall and Jiang.

Furthermore, without conceding the above-mentioned arguments, appellants challenge the assertion that it would have been obvious to combine certain aspects of Jiang and Tesink with Kall to produce the claimed invention. The Final Office Action has provided no reference, or other evidence to support the conclusion that it would be obvious to one skilled in the art to modify the system of Kall with the teachings of Jiang and Tesink, aside from conclusory statements such as, *"it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to apply the messaging service taught by Jiang into the system of Kall in order to provide guaranteed and scheduled delivery via Short Message Service (SMS) for quality assurance,"* and *"it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to apply the method of SMS multicasting between mobile nodes disclosed by Tesink into the SMS method of Kall and Jiang in order to provide short message service to users for generating service provider's revenue and satisfying user's new service request."*

A *prima facie* case of obviousness is not established absent proper motivation. Simply because certain teachings of Jiang and Tesink *could* be used in other communication systems, a motivation to modify Kall to meet the aforementioned limitations of claim 9 is not necessarily formed.

The Supreme Court's decision in *KSR International. Co. v. Teleflex, Inc., et al.*, 127 S.Ct. 1727, 1741 (2007) requires that an examiner provide "some articulated reasoning with some rationale underpinning to support the legal conclusion of obviousness." An examiner must "identify a reason that would have prompted a person

of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *Id.* And, the examiner must make “explicit” this rationale of “the apparent reason to combine the known elements in the fashion claimed,” including a detailed explanation of “the effects of demands known to the design community or present in the marketplace” and “the background knowledge possessed by a person having ordinary skill in the art.” *Id.* Anything less than such an explicit analysis is not be sufficient to support a *prima facie* case of obviousness.

In this case, the examiner fails to address why the primary reference to Kall, which defines a common channel and effectuates downloading of multicast data to each of the mobile user endpoints that are to receive such data, would be modified in such a manner as proposed. There is no teaching or suggestion in Kall of a modification whereby the data is actually obtained from the client. In essence, Kall teaches away from such a combination.

It seems that the examiner was motivated to combine these teachings for no other reason than to arrive at the claimed invention. This is a classic example of impermissible hindsight.

In view of the foregoing, Appellants respectfully submit that independent claim 9 patentably defines the present invention over the citations of record. Further, the dependent claims 2-8 are also allowable for the same reasons as their respective base claims and further due to the additional features that they recite.

- B. Claims 10-16 would not have been obvious over Kall in view of Jiang and further in view of Tesink

Claim 10 recites the steps of (a) receiving from a messaging client message content to be transmitted in a message and (b) receiving delivery information for first and second recipients to whom the message is to be transmitted. These steps are described, for example, in FIG. 4 and in paragraphs [0033-0037] of the specification.

Appellants submit that none of the cited references discloses at least the aforementioned features of independent claim 10. In particular, it is submitted that the additional citation to Tesink does not remedy the conceded deficiencies in the primary citation to Kall and in the secondary citation to Jiang. Accordingly, without conceding the propriety of the asserted combination, the asserted combination of Kall with Jiang and Tesink is likewise deficient, even in view of the knowledge of one of ordinary skill in the art.

The Final Office Action concedes that the primary citation to Kall does not disclose receiving from a messaging client message content to be transmitted in a message and receiving delivery information for first and second recipients to whom the message is to be transmitted. (Final Office Action, page 3). Nonetheless, the Final Office Action rejects independent claim 10, contending that the additional citation to Tesink provides this necessary disclosure. (Final Office Action, page 3). This contention is respectfully traversed.

Reference is made to FIG. 1 of Kall. As detailed in the corresponding columns 5 and 6 of Kall, the apparatus 46 includes an identifier 48 and a RANcast implementer 52. The identifier 48 identifies the number of mobile user endpoints that request, or shall likely request, download of multicast data from the multicast source to the respective

endpoints. For each cell defined by each base station of a particular RAN, the identifier 48 identifies how many mobile user endpoints request, or are likely to request, download of the multicast data. The implementer 52 defines a common channel and effectuates downloading of the multicast data to each of the mobile user endpoints that are to receive such data. Thus, the data is not obtained from the client, but rather, is delivered to the client.

This is quite different from the claimed invention. As presented in claim 9, the message is provided by a messaging client, whereby the message is delivered to multiple recipients. Thus, information flows from the creator of a message to multiple recipients via the exemplary messaging system.

The secondary citation to Jiang relates to a system and method for integrating wireless data and voice calls and is cited for its alleged disclosure of receiving a report indicating an outcome for the message transmission to the first recipient and receiving a report indicating an outcome for the message transmission to the second recipient. (Jiang, FIG. 1). Appellants submit that Jiang does not add anything that would remedy the aforementioned deficiencies of Kall.

The additional citation to Tesink relates to a multicasting notification system. (Tesink, FIG. 1.) Tesink discusses the concept of SMS based agents 604 for multicasting the message to SMS-based subscribers 618. But Tesink does not teach or suggest the concepts of receiving from a messaging client message content to be transmitted in a message and delivery information for first and second recipients to whom the message is to be transmitted. As such, Tesink does not add anything that would remedy the aforementioned deficiencies of Kall and Jiang.

Furthermore, without conceding the above-mentioned arguments, appellants challenge the assertion that it would have been obvious to combine certain aspects of Jiang and Tesink with Kall to produce the claimed invention. The Final Office Action has provided no reference, or other evidence to support the conclusion that it would be obvious to one skilled in the art to modify the system of Kall with the teachings of Jiang and Tesink, aside from conclusory statements such as, *“it would have been obvious to one of ordinary skill in the art at the time of applicant’s invention to apply the messaging service taught by Jiang into the system of Kall in order to provide guaranteed and scheduled delivery via Short Message Service (SMS) for quality assurance,”* and *“it would have been obvious to one of ordinary skill in the art at the time of applicant’s invention to apply the method of SMS multicasting between mobile nodes disclosed by Tesink into the SMS method of Kall and Jiang in order to provide short message service to users for generating service provider’s revenue and satisfying user’s new service request.”*

A *prima facie* case of obviousness is not established absent proper motivation. Simply because certain teachings of Jiang and Tesink *could* be used in other communication systems, a motivation to modify Kall to meet the aforementioned limitations of claim 10 is not necessarily formed.

The Supreme Court’s decision in *KSR International. Co. v. Teleflex, Inc., et al.*, 127 S.Ct. 1727, 1741 (2007) requires that an examiner provide “some articulated reasoning with some rationale underpinning to support the legal conclusion of obviousness.” An examiner must “identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new



invention does.” *Id.* And, the examiner must make “explicit” this rationale of “the apparent reason to combine the known elements in the fashion claimed,” including a detailed explanation of “the effects of demands known to the design community or present in the marketplace” and “the background knowledge possessed by a person having ordinary skill in the art.” *Id.* Anything less than such an explicit analysis is not be sufficient to support a *prima facie* case of obviousness.

In this case, the examiner fails to address why the primary reference to Kall, which defines a common channel and effectuates downloading of multicast data to each of the mobile user endpoints that are to receive such data, would be modified in such a manner as proposed. There is no teaching or suggestion in Kall of a modification whereby the data is actually obtained from the client. In essence, Kall teaches away from such a combination.

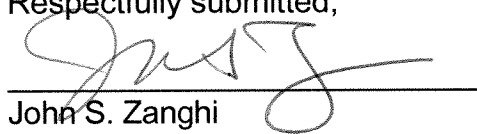
It seems that the examiner was motivated to combine these teachings for no other reason than to arrive at the claimed invention. This is a classic example of impermissible hindsight.

In view of the foregoing, Appellants respectfully submit that independent claim 10 patentably defines the present invention over the citations of record. Further, the dependent claims 11-16 are also allowable for the same reasons as their respective base claims and further due to the additional features that they recite.

CONCLUSION

For all of the reasons discussed above, it is respectfully submitted that the rejections are in error and that claims 2-16 are in condition for allowance. For all of the above reasons, Appellants respectfully request this Honorable Board to reverse the rejections of claims 2-16.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'John S. Zanghi', is written over a horizontal line.

John S. Zanghi  
Registration No. 48,843

FAY SHARPE LLP  
The Halle Building – 5<sup>th</sup> Floor  
1228 Euclid Avenue  
Cleveland, Ohio 44115  
Telephone: (216) 363-9000

Filed: *March 5, 2009*

## **APPENDICES**

### **VII. CLAIMS APPENDIX:**

Claims involved in the Appeal are as follows:

1. (Cancelled)
2. (Previously Presented) The method as set forth in claim 9 wherein the message content is received from an input device associated with the client.
3. (Original) The method as set forth in claim 2 wherein the input device includes at least one of a keypad, keyboard, pointing device, and voice recognition device.
4. (Previously Presented) The method as set forth in claim 9 wherein the message content is received from a saved message area associated with the client.
5. (Previously Presented) The method as set forth in claim 9 wherein the delivery information for the first and second recipients is received from at least one of an input device associated with the client and a previously stored list of contacts associated with the client.
6. (Previously Presented) The method as set forth in claim 9, step b) further including: receiving delivery information for one or more additional recipients to whom the message is to be transmitted.
7. (Previously Presented) The method as set forth in claim 6 wherein at least one of the additional recipients is a previously defined recipient group received from a stored list of contacts, the recipient group including delivery information for third and fourth recipients to whom the message is to be transmitted, the method further including the steps:
  - h) transmitting the message from the client to the third recipient; and

i) transmitting the message from the client to the fourth recipient.

8. (Previously Presented) The method as set forth in claim 9 wherein the instruction to begin message transmission is received from an input device associated with the client.

9. (Previously Presented) A method for client-based multicast message transmission, the method including the steps:

a) receiving from a messaging client a message content to be transmitted in a message;

b) receiving delivery information for first and second recipients to whom the message is to be transmitted;

c) receiving an instruction to begin the message transmission;

d) transmitting the message from the client to the first recipient; and

e) transmitting the message from the client to the second recipient;

f) receiving a report indicating an outcome for the message transmission to the first recipient; and

g) receiving a report indicating an outcome for the message transmission to the second recipient.

10. (Previously Presented) A method for client-based multicast message transmission, the method including the steps:

a) receiving from a messaging client a message content to be transmitted in a message;

b) receiving delivery information for first and second recipients to whom the message is to be transmitted;

c) receiving an instruction to begin the message transmission;

d) transmitting the message to the first recipient and a request for a response indicating an outcome for the message transmission;

e) transmitting the message to the second recipient and a request for a response indicating an outcome for the message transmission;

f) receiving a report indicating an outcome for the message transmission to the first recipient; and

g) receiving a report indicating an outcome for the message transmission to the second recipient.

11. (Original) The method as set forth in claim 10 wherein the message content, delivery information for first and second recipients, and instruction to begin the message transmission are received from an input device associated with the client.

12. (Original) The method as set forth in claim 11 wherein the input device includes at least one of a keypad, keyboard, pointing device, and voice recognition device.

13. (Original) The method as set forth in claim 10 wherein the message content is received from a saved message area associated with the client.

14. (Original) The method as set forth in claim 10 wherein the delivery information for the first and second recipients is received from a previously stored list of contacts associated with the client.

15. (Original) The method as set forth in claim 10, step b) further including:  
receiving delivery information for one or more additional recipients to whom the message is to be transmitted.

16. (Original) The method as set forth in claim 15 wherein at least one of the additional recipients is a previously defined recipient group received from a stored list of contacts, the recipient group including delivery information for third and fourth recipients to whom the message is to be transmitted, the method further including the steps:

h) transmitting the message to the third recipient and a request for a response indicating an outcome for the message transmission;

i) transmitting the message to the fourth recipient and a request for a response indicating an outcome for the message transmission;

j) receiving a report indicating an outcome for the message transmission to the third recipient; and

k) receiving a report indicating an outcome for the message transmission to the fourth recipient.

17. – 20. (Cancelled)

VIII. EVIDENCE APPENDIX

NONE

IX. RELATED PROCEEDINGS APPENDIX

NONE